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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,196	07/06/2000	Denise E. Smith	ATL99003	5114

7590 12/28/2001

Paul A. Roberts.  
MCIWorldCom. Inc.  
1133 19th Street, NW  
Washington, DC 20036

EXAMINER

BARNIE, REXFORD N

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/611,196

Applicant(s)

SMITH ET AL.

Examiner

Rexford Barnie

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 6, 2000
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6 20) ☐ Other: \_\_\_\_\_

Art Unit: 2643

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-5, 7-10, 12, 16, 22 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Stich et al. (US Pat# 5,760,381).

**Regarding claim 1**, Stich et al. teaches a pre-paid calling card comprising of calling card portion and a key ring portion wherein the key ring portion is separable by means (30) from a calling card portion (see figs. 1-9)

**Regarding claim 2**, Stich teaches the card could comprises of graphics and indicia.

**Regarding claim 3**, Stich teaches a hole which would enable one to insert in a key ring.

Note that any attachment with a sizeable hole can be fitted with a key ring, if desired.

**Regarding claim 4**, Stich teaches perforation (see 5-7 and column 4 lines 37-38).

**Regarding claim 5**, According to (see column 2 lines 58-60) may have a reasonable size comparable to conventional size.

Art Unit: 2643

**Regarding claims 7-10 and 12,** Stich teaches a pre-paid system wherein a plurality of cards can be generated with a PIN. Stich et al. teaches a pre-paid calling card comprising of calling card portion and a key ring portion wherein the key ring portion is separable by means (30) from a calling card portion (see figs. 1-9). Stich teaches the card could comprises of graphics and indicia. Stich teaches a hole which would enable one to insert in a key ring. Note that any attachment with a sizeable hole can be fitted with a key ring, if desired. According to (see column 2 lines 58-60) may have a reasonable size comparable to conventional size (see column 1 lines 5-7).

**Regarding claim 16,** A plurality of blank cards will be needed after which account information can be imprinted on this cards for use as pre-paid cards and so forth. The physical card taught by Klure would made by a manufacturing company with the conventional hardware and software means for printing pre-paid cards. Furthermore, see the explanation as set forth in the rejection of claim 7.

**Regarding claim 22,** A computer apparatus or means would generate these cards. Note “customization” is not limited to either the user or the manufacture according to the claim.

**Regarding claims 28-29,** Anticipated by Stich (see figures)

Art Unit: 2643

3. Claims 1-10, 12, 14, 15, 16, 22-24 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Klure (US Pat# 6,328,341).

**Regarding claim 1**, Klure teaches a prepaid calling card (see column 1 lines 8-13) comprising of a calling card and a key portion separable from each other by a perforation (see figs. 1-7).

**Regarding claim 2**, Klure teaches in (column 3 lines 31-33) that pictorial or photographic and other information designed to attract purchasers can be associated with the pre-paid calling card.

**Regarding claim 3**, Klure teaches a hole in (figs. 1-7).

**Regarding claim 4**, Klure teaches in (figs. 1-7), a perforation separating a key ring portion from a calling card portion.

**Regarding claim 5**, Klure teaches being able to use the card in an ATM machine (see column 5 lines 19-30).

**Regarding claim 6**, Klure teaches in (figs. Fig. 3) the claimed limitation comprising of a key ring portion with an identification number and also, a calling portion with an identification number.

**Regarding claim 7-10, 12 and 15**, Klure teaches arguably manufacturing a plurality of cards usable by a plurality of users. Klure teaches a prepaid calling card (see column 1 lines 8-13) comprising of a calling card and a key portion separable from each other by a perforation (see figs 1-7). Klure teaches in (column 3 lines 31-33) that pictorial or photographic and other information

Art Unit: 2643

designed to attract purchasers can be associated with the pre-paid calling card. Klure teaches a hole in (figs. 1-7) and a perforation separating a key ring portion from a calling card portion. Klure teaches in (figs. Fig. 3) the claimed limitation comprising of a key ring portion with an identification number and also, a calling portion with an identification number.

**Regarding claim 14**, Klure teaches in (fig. 3), an identification number imprinted on both a key ring portion and a calling card portion.

**Regarding claim 16**, A plurality of blank cards will be needed after which account information can be imprinted on this cards for use as pre-paid cards and so forth. The physical card taught by Klure would made by a manufacturing company with the conventional hardware and software means for printing pre-paid cards. Furthermore, see the explanation as set forth in the rejection of claim 7. Note, the customization could be to the specification of the manufacturer of the cards. Note “customization” is not limited to either the user or the manufacture according to the claim.

**Regarding claim 22**, A computer apparatus or means would generate these cards. Note “customization” is not limited to either the user or the manufacturer according to the claim.

**Regarding claims 23-24**, Klure teaches the claimed limitations (see column 3 lines 31-33 and fig. 3).

**Regarding claims 28-29**, Klure anticipates the claimed limitations (see figs.).

Art Unit: 2643

4. Claims 1-11, 15, 22 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (US Pat# 6,269,158).

**Regarding claims 1-6,** Kim teaches a calling card with other purposes (see column 1 lines 5-10) including advertising, scenic photographs, images and so on (see column 3 lines 45-50). According to (see figs. 1-10), a key ring portion (see column 3 lines 36-38) can be separated from a calling card portion by means of perforation. The card would have a conventional size according to drawings with a PIN (see column 3 lines 51- 64 and column 4 lines 57-63). Note the hole taught by Kim can receive a key ring, if desired by a party.

**Regarding claims 7-10 and 15,** Kim teaches a plurality of calling card t be manufactured and sold to users with PINs which makes it possible to authenticate users based on a unique account number which would be debited based on usage. Furthermore, Kim teaches a calling card with other purposes (see column 1 lines 5-10) including advertising, scenic photographs, images and so on (see column 3 lines 45-50). According to (see figs. 1-10), a key ring portion (see column 3 lines 36-38) can be separated from a calling card portion by means of perforation. The card would have a conventional size according to drawings with a PIN (see column 3 lines 51- 64 and column 4 lines 57-63). Note the hole taught by Kim can receive a key ring, if desired by a party. Kim teaches either a calling card which could be a credit card adapted fro making phone calls and/or pre-paid

**Regarding claim 22,** A computer apparatus or means would generate these cards. Note “customization” is not limited to either the user or the manufacture according to the claim.

Art Unit: 2643

**Regarding claims 28-29, Anticipated by Kim (see figs.)**

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over (claim 7)'s.

Rejection in view of Fonseca (US Pat# 5,629,977).

**Regarding claim 13,** The primary reference fails to teach the claimed subject matter but Fonseca teaches a calling card in conjunction with a greeting card wherein (see fig. 4), an account number + PIN (see column 4 lines 23-44) can be printed on two section separable by perforation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Fonseca into that of the primary reference thus making it possible to still make calls by using a separated portion of a prepaid calling card without having to carry the entire card or in case one loses one portion of the card, one can still have a portion with an account identifier.



Art Unit: 2643

7. Claims 7 and 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim or Klure or Stich in view of Fonseca (US Pat# 5,640,447) or Small (US Pat# 5,513,117) or vice-versa "Small" in view of (Klure or Kim or Stich).

**Regarding claims 7, 15 and 16,** Kim or Klure or Stich fails to teach customizing a calling card but Fonseca teaches a prepaid calling card which can be customized specific to a user (see column 7 lines 17-32).

Small teaches a computer apparatus for customizing a card which can be used for telecommunications services as well by using blank cards (see abstract and entire disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small or Fonseca into that of (Kim, Klure or Stich) thus making it possible to customize a card as desired by a user.

**Regarding claims 17-21,** see the explanation as set forth in the rejection of claims 1-14.

**Regarding claims 22-24,** If the customization is done by a user instead of a manufacturing. Then, the claim is still rejectable under (Klure or Kim or Stich) in view of Small.

**Regarding claim 25,** (Kim or Klure or Stich) teaches a card with two portions namely; a key ring portion and a calling card portion which in view of Small, if considered as blanks cards stored in the machine taught by Small, can be modified or customized to include any desired information

**Regarding claims 26-27,** the combination teaches the claimed limitations.

Art Unit: 2643

8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim or Klure or Stich.

**Regarding claim 30,** The limitation is not specifically taught by the primary references but the examiner takes official notice that it's well known to place instructions such as "tear along the perforated line" or something to that effect where there is perforation(s) separating two portions of an article..

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this teaching into that of the primary references as means of guiding a user on how to tear or separate two portions of an article.

***Conclusion***

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to REXFORD BARNIE whose telephone number is (703) 306-2744. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

or faxed to (703) 872-9314 and labeled accordingly (Please label **"PROPOSED/INFORMAL"** or **"FORMAL"**).

Art Unit: 2643

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 306-0377.

  
Rexford Barnie  
Patent Examiner  
RB 12/19/01.